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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,673	07/28/2003	Hajime Sasaki	HIRA.0118	4610
38327	7590	03/17/2010		
Juan Carlos A. Marquez			EXAMINER	
c/o Stites & Harbison PLLC			QAYYUM, ZESHAN	
1199 North Fairfax Street				
Suite 900			ART UNIT	PAPER NUMBER
Alexandria, VA 22314-1437			3685	
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			03/17/2010	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/627,673	SASAKI ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	ZESHAN QAYYUM	3685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 15 December 2009.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 1 and 5-7 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1 and 5-7 is/are rejected.

7) Claim(s) 1 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

**Status of Claims**

1. Claims 1, 5-7 have been examined.
2. Claims 2-4 have been canceled by the Applicant.

***Response to Arguments***

3. Applicant's arguments with respect to claim have been considered but are moot in view of the new ground(s) of rejection.

***Claim Objections***

4. Claim 1 is objected to because of the following informalities: Claim 1 recite in line 12 "medical information data that *include including* medical records..."  
Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 5-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

6. Claims 5-7 discloses: "...a plurality of patient terminals....a respective patient identifier of the plurality of patient identifiers, the first patient ...with the first patient identifier". These limitations were not described in the specifications.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
8. Claim 1 recites the limitation "the respective patient terminal" in line 17, "the patient" in line 18. There are insufficient antecedent basis for these limitations in the claim.
9. Claim 1 recites "a method" and "a plurality of medical institution terminals" in line 20 and 23 respectively. It is unclear to one of the ordinary skill in art that is this method and medical institution terminals same as recited in line 1 and 4 respectively (In re Zletz, 13 USPQ2d 1320 (Fed. Cir. 1989)).
10. Claim 1 is directed to a method. Claim also states "wherein management server comprises..." The scope of the claim is unclear. It is unclear to one of the ordinary skill is this claim directed to method or method and system? (In re Zletz, 13 USPQ2d 1320 (Fed. Cir. 1989)).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Menschik (US 7234064) in view of Tipirneni (US 6381029).

12. With respect to claims 1, 5-7, Menschik discloses: receiving a first request transmitted over the network from a first medical institution terminal of a plurality of medical institution terminals, the first request being a medical information reference request to allow a medical institution terminal of the plurality of medical institution terminals to download a first set of medical information data stored in the medical information storage device, the first set of medical information data being associated with a first patient of the plurality of patients (See column 6, lines 21-67, column 21, lines 16-20) transmitting a second request over the network to a first patient terminal of the plurality of patient terminals configured to be used by the first patient, the second request requesting permission to allow the medical institution terminal to download the first set of medical information data (See column 6, lines 21-67 and column 22 lines 24-40) receiving a first response over the network from the first patient terminal allowing the medical institution terminal to download the first set of medical information data (See column 6, lines 21-67 and column 22 lines 24-60) Menschik further discloses

transmitting the requested data to the medical institution terminal (See column 6 lines 21-67). Menschik does not explicitly disclose: transmitting a download/upload key for accessing the first set of medical information data in the medical information storage device to the second medical institution terminal; generating reference permission data for the second medical institution terminal to download the first set of medical information data from the medical information storage device that is associated with the download key and the second medical institution terminal; receiving a third request from the second medical institution terminal requesting to download the first set of medical information data from the medical information storage device, the third request including the download key; validating that the second medical institution terminal is permitted to download the first set of medical information data from the medical information storage device using the download key included in the third request according to the reference permission data; accessing the medical information storage device to retrieve the first set of medical information data; transmitting a representation of the first set of medical information data to the second medical institution terminal.

*Tipirneni* discloses: transmitting a download/upload key (i.e. password) for accessing the first set of medical information data in the medical information storage device to the second medical institution terminal; generating reference permission data for the second medical institution terminal to download the first set of medical information data from the medical information storage device that is associated with the download key and the second medical institution terminal;

receiving a third request from the second medical institution terminal requesting to download the first set of medical information data from the medical information storage device, the third request including the download key; validating that the second medical institution terminal is permitted to download the first set of medical information data from the medical information storage device using the download key included in the third request according to the reference permission data; accessing the medical information storage device to retrieve/update the first set of medical information data; transmitting a representation of the first set of medical information data to the second medical institution terminal (See column 7, lines 1-67 and column 8, lines 1-62). Therefore, it would have been obvious to one of the ordinary skill in the art at the time invention was made to modify Menschik reference with Tipirneni reference in order to provide extra security in data access.

In addition the claims recite the functional language for. Applicant is reminded that functional recitation(s) using the word "for" or other functional language (e.g. "capable of", "to allow") have been considered but given less patentable weight because they fail to add any steps and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.).

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Negel (US 7181017) discloses system and method for secure three party communications.
- Viets (6357010) discloses system and method for controlling access to documents stored on an internal network.
- Shelton (US 7664753) discloses Standing order database search system and method for internet and intranet application.
- Internet based repository of medical records that retains patient confidentiality by Ray Schoenberg.
- Hacker (US 6988075) discloses Patient controlled medical information system and method.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory

action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ZESHAN QAYYUM whose telephone number is (571)270-3323. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Z. Q./  
Examiner, Art Unit 3685

/Calvin L Hewitt II/  
Supervisory Patent Examiner, Art Unit 3685